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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10 056,352	01/24/2002	Gregory Mathus	5043CON	8045

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EXAMINER

KOYAMA, KUMIKO C

ART UNIT PAPER NUMBER

2876

DATE MAILED: 01/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/056,352

Applicant(s)

MATHUS ET AL

Examiner

Kumiko C. Koyama

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any entitled patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-36 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 22-36 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7 6) ☐ Other

DETAILED ACTION

- 1 Acknowledgment is made of Amendment filed on November 13, 2002.

Claim Rejections - 35 USC § 103

- 2 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made

- 3 Claims 22-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wijnschenk et al (US 6,270,728) in view of Moh et al (US 6,165,594).

Wijnschenk shows a test tube (FIG 1) comprising an enclosed sidewall 2 and an integral bottom surface 6 that together define a tubular container 1 having an open top 20, wherein the bottom surface has a concave interior surface 3 and a planar exterior surface 7 upon which machine readable coding 9 is encoded on a label, having a light-coloured background on which a contrasting pattern of dots (col 1 lines 59-65) is printed, deposited onto the planar exterior surface 7 to uniquely identify the test tube (col 1 lines 20-22). Wijnschenk also teaches that the machine readable coding is applied to an optically opaque background to ensure the machine readable coding is readable at all times with an optical reading mechanism (col 1 lines 66+).

Re claims 22, and 29: Wijnschenk fails to teach that the machine readable coding is encoded within a multi-layered opaque coatings of contrasting colors.

Moh teaches a machine readable label (col 1 lines 19-23) having a multilayered construction (col 3 lines 16-17), where a top layer of one color overlies a layer of a contrasting color (col 2 lines 58-59). Moh discloses that the label is attached to identify and track a product (col 2 lines 67+) made out of a substrate 12, which includes glass (col 5 lines 43-44).

Re claims 23, 25, 27 and 30: Moh shows a label 10, which includes base layer 14 and top layer 16, attached to a substrate 12 (FIG 1, col 5 lines 32-33). Moh teaches a formation of a code pattern by removing portions of the top layer 16 to expose the underlying base layer 14, so that the code is optically discernible (col 7 lines 12-20). Moh also teaches that layer 14 and layer 16 are contrasting colors (col 7 lines 13-15), and that layer 14 is white and layer 16 is black (col 7 lns 26-27)

Re claim 24, 26 and 32: Moh teaches that selected portions of the second layer are removed by exposure to laser ablating techniques (col 8 lines 9-15).

Re claim 28: Moh teaches that the label may comprise metal (col 2 lines 4-12).

Re claim 31: Moh teaches that the label may comprise metal (col 2 lines 4-12). Although Moh does not disclose the exact word "hot stamping," he discloses that for forming a multilayer label, layers may be stacked and laminated together using appropriate pressure and temperature (col 16 lines 1-2).

In view of Moh's teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate Moh's label to the teachings of Wijnschenk and create a multilayered opaque coatings of contrasting colors because it would have resulted in more distinct color contrast of the coding and distinctive opaqueness of the background, therefore resulting in reducing the error rate in reading the code.

4. Claims 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wijnschenk as modified by Moh as applied to claim 24 and 32 above, and further in view of Mizobuchi et al (U.S. 6,133,342). Wijnschenk as modified by Moh have been discussed above.

Wijnschenk as modified by Moh fail to teach that the opaque coating undergoes a change in color when exposed to the coherent light source, includes a light sensitive pigment that undergoes the change in color, and the change in color is effected by altering the color of the light sensitive pigment included in the opaque coating.

Mizobuchi discloses an opaque coating composition comprising a colorant (col 2 lines 57-60) and a substrate is coated with the composition (col 2 lines 45-46). Mizobuchi further discloses that upon irradiating the substrate with a laser beam according to the predetermined marking pattern, the polymeric material becomes translucent or transparent, and as a result, the colorant is made visible. The visible mark is created on the substrate (col 2 lines 47-53). The colorant comprises a pigment and may be in different colors, such as blue, red, or yellow (col 10 lines 1-2 and 44-45, col 12 line 9).

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Mizobuchi to the teachings of Wijnschenk as modified by Moh because the modification provides the code marking with more variety of colors, which is easily visible and recognizable by human eye. Such modification also helps place the test tube in a correct category or location by using the color differences in order to prevent the test tube from getting lost within a lab.

Response to Arguments

5 Applicant's arguments filed on November 13, 2002 have been fully considered but they are not persuasive.

In response to Applicant's argument that "There is neither a disclosure nor a suggestion in Wijnschenk et al of applying either single or multiple layered coatings directly to a bottom surface of the test tube . . . There certainly is no cross teachings in either Wijnschenk et al or Moh et al that would suggest combining them to render obvious the concept of encoding machine readable data within coatings applied to the bottom surfaces of the test tubes," the examiner respectfully submit to the Applicant that "It is not necessary that the references actually suggest, expressly or in so many words, changes or possible improvements. All that is required is that the invention was made by applying knowledge clearly present the prior art." In re Scheckler, 58 CCPA 936, 438 F. 2d 999, 168 USPQ 716 (1971). Furthermore, the examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969.

In this case, the primary reference Wijnschenk and the secondary reference Moh teach a code pattern. Wijnschenk teaches an optically readable coding applied to the bottom end of a test tube. Moh teaches a label having a code pattern formed.

The specifics that were taught in Wijnschenk was that a test tube defined as a tubular container was provided with an optically readable coding on the bottom end of the test tube. The optically readable coding further taught to be a dot matrix and the dot matrix is applied to an optically opaque surface to ensure that the optically coding is readable at all times with an optical reading mechanism. Here, Wijnschenk shows or teaches that an identification means is applied to a test tube, specifically on the bottom of the test tube, and such identification means is improved by applying onto an opaque surface.

The examiner relied on the secondary reference Moh because Moh teaches a material used for labeling a substrate. The examiner considered a label to be an identification means that may be applied to any item to identify the item or content of the item. Moh also teaches that the material for labeling a substrate includes a code pattern and is optically discernible and a detector means, such as a bar code reader, to detect the code pattern. Such common characteristics provided the examiner to suggest the combination of the two references.

Therefore, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate or modify the teachings of Wijnschenk to the teachings of Moh given that both suggest an identification means having a code pattern and in addition, provides a more distinctive color contrast so that there is less or no error in reading the code pattern.

Conclusion

6 Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kumiko C. Koyama whose telephone number is 703-305-5425. The examiner can normally be reached on Monday-Friday 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 703-305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

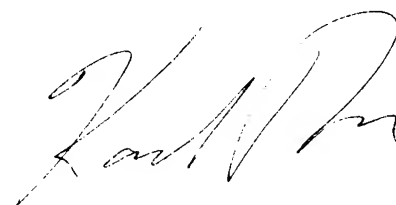
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kek

January 13, 2003

A handwritten signature in cursive script, appearing to read 'Karl D. Frech'.

KARL D. FRECH
PRIMARY EXAMINER